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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/754,969	01/05/01	HUANG	E 2276-02

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EXAMINER	
BASHORE, W	
ART UNIT	PAPER NUMBER
2176	7

DATE MAILED: 09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/754,969	HUANG, Evan S.
Examiner	**Art Unit**
William L. Bashore	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 27, 2001*

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-42* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 7/27/2001, to the original application filed on 1/5/2001, with provisional filing date of **1/31/2000**. IDS filed on 4/23/2001 and 4/25/2001.

2. Examiner acknowledges petition to make special under MPEP 708.02 VIII, filed on 4/25/2001, said petition granted on 6/8/2001.

3. Examiner acknowledges Applicant's minor changes to the specification.

4. The objection to the title of the invention has been with withdrawn as necessitated by amendment.

5. Claims 1-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale and Fuji Xerox.

6. Claims 1-42 are pending in this case. Claims 1, 15, 25, 39 are independent claims.

Claim Rejections - 35 USC § 103

7. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (hereinafter Borgendale), U.S. Patent No. 5,276,793 issued January 1994, in view of Fuji Xerox (hereinafter Fuji Xerox), Japanese Application - Pub. No. JP 08030619 A, with publication date of February 2, 1996.**

In regard to independent claim 1, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 1 "*a method of producing structured documents, the method comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 1 "*receiving a definition file including document type definitions (DTD)*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 19-21 - middle section in each figure; compare with claim 1 "*...the metafile including a number of displayable objects*", and "*respective decoration attributes about each of the displayable objects*").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with claim 1 "*displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to create better documents by visualizing its structural mapping.

- a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21; compare with claim 1 "*associating at least one of the definitions in the definition file with one of the displayable objects*").

- creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 1 "*creating the structured document from the metafile....with one of the displayable objects*").

In regard to dependent claim 2, Borgendale teaches style information in the form of an "MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 2).

In regard to dependent claim 3, Borgendale teaches converting a document with metafile to SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32, Figures 5, 11, 12; compare with claim 3).

In regard to dependent claim 4, Borgendale teaches a document type definition, which describes a structure for document elements corresponding to displayable objects in a metafile (Borgendale column 6 lines 34-37; compare with claim 4).

In regard to dependent claim 5, Borgendale teaches document elements in a hierarchical presentation, each corresponding to objects in a metafile (Borgendale Figure 11; compare with claim 5).

In regard to dependent claim 6, Borgendale teaches document identifiers associated with elements and pointers (Borgendale Figures 11, 12; compare with claim 6).

In regard to dependent claims 7-8, Borgendale teaches identifiers as alphanumeric text, as well as font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claims 7-8).

In regard to dependent claims 9-11, Borgendale teaches a construction module used for the creation/modification of documents associated with DTDs utilizing defined/modified looks, user modification of said document with respect to alphanumeric text, color, font, size, and style results in changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claims 9-11).

In regard to dependent claims 12-14, Borgendale teaches an editor whereby a user can generate documents associated with a DTD, said document can be initially generated as a text document, and resulting "look" of said document reflects characters, font, size, etc. (Borgendale Abstract, near top, also Figures 11-12; compare with claims 12-14).

In regard to independent claim 15, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 15 "*a method of producing structured documents, the method comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 15 "*a definition file including...document type definitions includes an identifier*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 11-12, 19-21 - middle section in each figure; compare with claim 15 "*...wherein the metafile including a number of displayable objects*", and " *and respective decoration attributes about*

each of the displayable objects, and wherein each of the document type definitions includes an identifier").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with claim 15 "*activating an environment including a first display and a second display...including document type definitions (DTD)* ", and *"displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to produce better documents by visualizing its structural mapping.

- Borgendale teaches a document construction module comprising groups of DTDs and corresponding sets of base-styles (Borgendale column 8 lines 40-46; compare with claim 15 "*grouping a number of group objects, each of the group objects including a number of the displayable objects*").

- a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21; compare with claim 15 "*associating each of the group...in one of the document type definitions*").

- creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 15 "*creating the structured document from the metafile....with one of the displayable objects*").

In regard to dependent claim 16, Borgendale teaches style information in the form of an "MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 16).

In regard to dependent claim 17, Borgendale teaches converting a document with metafile to SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32, Figures 5, 11, 12; compare with claim 17).

In regard to dependent claim 18, Borgendale teaches a markup language (SGML) which is generally suitable for display on applications made to interpret said language (Borgendale column 6 lines 25-33; compare with claim 18).

In regard to dependent claims 19-20, Borgendale teaches SGML (Borgendale column 6 lines 25-33). Borgendale does not specifically teach the Internet. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, because SGML and hypertext suggests an Internet embodiment, providing the advantage of a familiar communication medium to Borgendale.

In regard to dependent claims 21-22, Borgendale teaches an editor whereby a user can generate documents associated with a DTD, said document can be generated as a text document, and resulting "look" of said document reflects characters, font, size, etc., as well as resulting character objects (Borgendale Abstract, near top, also Figures 11-12; compare with claims 21-22).

In regard to dependent claim 23, Borgendale teaches identifiers as alphanumeric text, as well as font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claim 23).

In regard to dependent claim 24, Borgendale teaches a construction module used for the creation/modification of documents associated with DTDs utilizing defined/modified looks, user modification of said document with respect to alphanumeric text, color, font, size, and style results in changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claim 24).

In regard to independent claim 25, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 25 "*a machine readable medium...the machine readable medium comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 25 "program code for *receiving a definition file including document type definitions (DTD)*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 19-21 - middle section in each figure; compare with claim 25 "*...the metafile including a number of displayable objects*", and "*and respective decoration attributes about each of the displayable objects*").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with

claim 25 "*program code for displaying a metafile along with the definition file...*", and "*displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to visualize structural mapping.

- a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21; compare with claim 25 "*program code for associating at least one of the definitions in the definition file with one of the displayable objects*").

- creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 25 "*program code for creating the structured document from the metafile....with one of the displayable objects*").

In regard to dependent claims 26-38, claims 26-38 reflect the machine readable medium comprising computer readable instructions for performing the methods as claimed in claims 2-14 respectively, and are rejected along the same rationale.

In regard to independent claim 39, Borgendale teaches:

- an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 39 "*a machine readable medium... the machine readable medium comprising:*").

- receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 39 "*a definition file including...document type definitions includes an identifier*").

- a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 11-12, 19-21 - middle section in each figure; compare with claim 39 "*...wherein the metafile including a number of displayable objects*", and "*and respective decoration attributes about each of the displayable objects, and wherein each of the document type definitions includes an identifier*").

- a document type definition with a file indicating a base style for a document (a metafile) (Borgendale column 13 lines 18-30). Borgendale does not specifically teach display of said metafile with a DTD and objects. However, Fuji Xerox teaches a document editing device which performs structure editing of a document displayed as a table, based on a DTD (Fuji Xerox Abstract, also Figures 4-11; compare with claim 39 "*program code for activating an environment including a first display and a second display...including document type definitions (DTD)* ", and "*displayable objects being displayed*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fuji Xerox to Borgendale, because of Fuji Xerox's taught advantage of graphical displays regarding structured files, providing a user of Borgendale a way to visualize structural mapping.

- Borgendale teaches a document construction module comprising groups of DTDs and corresponding sets of base-styles (Borgendale column 8 lines 40-46; compare with claim 39 "*program code for forming a number of group objects, each of the group objects including one or more of the displayable objects*").

- a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale column 13 lines 18-30, Figures 19-21; compare with claim 39 "*program code for associating each of the group...in one of the document type definitions*").

- creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 39 "*program code for creating the structured document from the metafile....with one of the displayable objects*").

In regard to dependent claims 40, 41, 42, claims 40, 41, 42 reflect the machine readable medium comprising computer readable instructions for performing the methods as claimed in claims 16, 17, 21 respectively, and are rejected along the same rationale.

9. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Poole et al. U.S. Patent No. 6,006,242 issued December 1999

Response to Arguments

10. Applicant's arguments filed 7/27/2001 have been fully and carefully considered but they are not persuasive.

Applicant argues on page 8 of the amendment that the Examiner misinterprets Applicant's claimed metafile as defined by Applicant's invention. The Examiner notes that a metafile acts to define other files (ie. structure, etc.). Borgendale teaches a document construction module for editing a document according to a document type definition (a metafile), which defines the structure of various documents with decorative attributes (ie. font, etc). Since said document is displayed to a user (for editing purposes), the document objects are also displayed, with said objects associated with both said document and its document type definition. In further support of this, Fuji Xerox, teaches (visible) structured editing of a document displayed

as a table, based upon a document type definition, with Fuji Xerox Figures 4-11, at the very least, suggests display and mapping of structured document objects.

Applicant argues on pages 9-10 of the amendment that Borgendale teaches away from Applicant's invention, and that both references do not teach a metafile as described and claimed by Applicant. The Examiner notes that Borgendale teaches an editing system for creating, editing, and printing a document according to the constraints adhered to within a selected document type definition. Borgendale teaches an editor for displaying a document. Fuji Xerox teaches the displayable structure of a document associated with a document type definition, and at the very least, suggests, along with Borgendale, grouping of structures.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**. The fax number to this art unit is **(703) 308-6606**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 305-9724 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

William L. Bashore
9/5/2001

JOSEPH H. FEILD
PRIMARY EXAMINER